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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,838	10/16/2000	Slavik Kasztelan	PET-1866	3445

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EXAMINER
ILDEBRANDO, CHRISTINA A

ART UNIT	PAPER NUMBER
1725	

DATE MAILED: 02/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/603,838	KASZTELAN ET AL.	
	Examiner	Art Unit	
	Christina Ildebrando	1725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 January 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12 and 14-25* is/are pending in the application.

4a) Of the above claim(s) *14-18* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12 and 19-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

2. The amendment filed 1/16/03 has been entered. Currently claims 1-12 and 19-25 are pending. Claims 14-18 remain withdrawn from consideration by the examiner as drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 5-12, and 19-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Usui et al.

Usui et al. (US 4,585,748) discloses a catalyst composition useful in hydroprocessing methods such as hydrocracking. The catalyst composition comprises: 5-90% by weight of a crystalline aluminosilicate zeolite, 5-90% by weight of a porous inorganic oxide, 1-20% of a Group VI metal component, 0-7% by weight of a Group VIII metal, and a third component selected from a phosphorus component and a boron component (column 3, lines 1-40). The amounts of materials taught and exemplified by the reference meet the instantly claimed amounts.

Suitable zeolites include zeolite Y (column 4, lines 30-35). The use of zeolite Y is exemplified. Preferred matrix materials include alumina and silica alumina (column 5, lines 5-15). Suitable Group VI metals include molybdenum and suitable Group VIII metals include nickel (column 5, lines 30-45). The use of nickel in combination with molybdenum is exemplified. It is taught that the hydrogenation metal components, i.e. Group VI and VIII metals, may be sulfurized (column 5, lines 65-69).

Usui et al. teaches that the composition is prepared by forming a support comprising the zeolite and matrix material, followed by contacting the support with the Group VI and Group VIII metals and promoters (column 8, lines 10-30). It is the position of the examiner that given the method of preparation taught by the reference, at least some of the metals would inherently be deposited on the matrix and at least some of the metals would inherently be deposited on the zeolite. When the examiner has reason to believe that the functional language asserted to be critical for establishing novelty in claimed subject matter may in fact be an inherent characteristic of the prior art, the burden of proof is shifted to Applicants to prove that the subject matter shown in the prior art does not possess the characteristics relied upon. *In re Fitzgerald et al.* 205 USPQ 594.

With regards to claim 7, which requires the presence of both boron and silicon, it is noted by the examiner that the Usui et al. reference teaches that silica can be added to the alumina matrix. Refer to column 5, lines 5-30. It is the position of the examiner that this added silica would meet the limitation of promoter, given the ranges and quantities instantly claimed.

The process limitations in claims 10-11 are noted. However, when the examiner has found a substantially similar product as in the applied prior art, the burden of proof is shifted to applicant to establish that their product is patentably distinct and not the examiner to show the same process of making. *In re Brown*, 173 USPQ 685 and *In re Fessmann*, 180 USPQ 324.

As each and every element of the claimed invention is taught in the prior art as recited above, the claims are anticipated by Usui et al.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Usui et al. as applied to claims 1-2, 5-12, and 19-25 above, and further in view of Koepke et al.

Usui et al. is applied as above for claims 1-2, 5-12, and 19-25.

Usui et al. does not specifically teach the use of a dealuminated zeolite.

Koepke et al. (US 4,777,157) teaches that for hydrocracking processes, the use of a Y zeolite in dealuminated form is preferred (column 2, line 60- column 3, line 10).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the disclosure of Usui et al. to include the use of a

dealuminated zeolite Y in light of the teachings of Koepke et al. Usui et al. teaches the use of zeolite Y. One would have been motivated by the teachings of Koepke et al. to specifically choose a dealuminated zeolite Y in light of the disclosure that in hydrocracking operations, the use of a dealuminated zeolite Y is conventional and preferred.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Usui et al. as applied to claims 1-2, 5-12, and 19-25 above, and further in view of Shi et al.

Usui et al. is applied as above for claims 1-2, 5-12, and 19-25 above.

Usui et al. does not teach that the catalyst composition contains elements of group VIIA.

Shi et al. (US 5,972,832) discloses a catalyst composition useful in hydrocracking processes. Shi et al. teaches that the catalyst composition comprises fluorine, nickel and tungsten oxides, alumina, and a zeolite such as Y zeolite (column 2, lines 20-25 and column 4, lines 5-6).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the invention of Usui et al. in light of the teachings of Shi et al. Shi et al. teaches that additional catalyst ingredients, such as fluorine, are known in the art and are useful when combined with a faujasite zeolite such as zeolite Y. Because both catalysts can be used in the same or similar processes of use, one would have reasonable expectation of success from the combination.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-12 and 19-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 and 22 of copending Application No. 09/603,837. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Copending application No. 09/603,837 discloses and claims a catalyst comprising at least one matrix, at least one zeolite, at least one element that is located at the matrix and selected from the group consisting of groups VIB, VIII, and VB, at least one promoter element, wherein the zeolite contains at least one element of group VB in its porous network (claim 1). The zeolite also contains at least one element of group VI and/or group VIII in its porous network (claim 4).

The difference between the instant claims and the claims of '837 is that the instant claims do not require the presence of a group VB element. However, one of

ordinary skill would recognize that the instant claims do not exclude the presence of additional elements, even in major proportions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented

Response to Arguments

10. Applicant's arguments with respect to claims 1-12 and 19-25 have been considered but are moot in view of the new ground(s) of rejection.

11. The Declaration under 1.132 has been considered but is not persuasive. The Declaration does not provide a comparison with the closest prior art and does not provide evidence commensurate in scope with what has been claimed. Additionally, evidence of unexpected results are not relevant to rejections under 102(b).

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christina Ildebrando whose telephone number is (703) 305-0469. The examiner can normally be reached on Monday-Friday, 7:30-5, with Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (703) 308-33183318. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

CAI
January 28, 2003

TOM DUNN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700